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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/183,791 10/30/98 JACOVES

P FMSI-24.440

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LM02/0709

EXAMINER

SATTIZAHN, B

ART UNIT	PAPER NUMBER
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2762

DATE MAILED:

07/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/183,791

Applicant(s)
Jacoves et al.

Examiner
Brian Sattizahn

Group Art Unit
2762



☒ Responsive to communication(s) filed on May 12, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-46 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Oct 30, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 818 in Figure 8 and 2414 in Figure 24. Correction is required.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 100. Correction is required.
3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. The disclosure is objected to because of the following informalities:

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page 1, line 4, the missing serial number must be inserted;

page 11, line 19, following "in Figure" '4' should be replaced by --5--; and

page 15, line 23, following "in Figure" '4' should be replaced by --6--.

Appropriate correction is required.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 17, 19, 39 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17, 19, 39 and 41 recite the phrases "may be" or "can be" in the limitations of the claims which renders the scope of the claims indefinite because it is not certain whether or not the subject matter of the limitation is part of the claimed invention.

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Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 7, 14-21, 23, 25-27, 31, 36-43 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Greer et al., European Patent No. 0 511 463 A2.

With regard to Claims 1 and 25, Greer et al. discloses discriminating discount triggering items from non-discount triggering items in a purchase of multiple items, each of the discount triggering items having a unique code associated therewith and an associated discount value (see Col. 7, lines 10-22, describing the detecting of a purchase of a triggering product based on the UPC code and the subsequent obtaining of the discount terms from a database), grouping the discount triggering items in bundles, each bundle comprised of all of the ones of the discount triggering items having the same unique code such that there is provided a bundle for each of the unique codes being present in the purchase of the multiple items and wherein each bundle has an associated bundle total (see Col. 7, lines 24-31, describing incrementing the count of the number of items purchased of a particular UPC code in the discount list, thereby bundling like products and which would inherently determine a bundle total by multiplying the number of items in the

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group by the discount amount), summing the bundle totals to provide a single redemption value for the redemptionable item (see Col. 5, lines 40-43, describing the accumulating the discount of multiple items in an order) and issuing redemption information having contained therein each bundle associated with its unique code and the associated bundle total and redemption value (see Col. 9, lines 29-45, describing that the cumulative discount certificate includes the list of triggering products and discount amounts).

With regard to Claims 2 and 26, Greer et al. discloses the step of grouping the discount triggering items in bundles is performed at the end of a transaction, which transaction comprises the receipt of all of the multiple items purchased by a purchaser (see Col. 7, line 34-37, describing the maintaining of the discount list until the end of the transaction).

With regard to Claims 3 and 27, Greer et al. discloses step of grouping further comprises the step of filtering in accordance with predetermined criteria, which of the discount triggering items are to be included in a bundle (see Col. 9, lines 49-55, describing the testing, based on certain criteria, to see if items should be included in the discount certificate).

With regard to Claims 7 and 31, Greer et al. discloses step of issuing cash register receipt information reflecting the retail price of each of the multiple items, including both the discount triggering items and the non-discount triggering items (see Col. 6, lines 42-45, describing the use of the printer for printing receipts which would inherently list all purchased items).

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With regard to Claims 14 and 36, Greer et al. discloses receiving a plurality of items comprised of discount triggering items and non-discount trigger items (see Col. 7, lines 10-15), inputting each of the received plurality of items to determine the unique codes associated therewith (see Col. 7, lines 7-10) and determining which of the inputted items have a unique code associated with the discount triggering item (see Col. 7, lines 10-15).

With regard to Claims 15 and 37, Greer et al. discloses providing a database having stored therein discount triggering items and their associated codes (see Col. 5, lines 30-35), and the step of determining which of the received items or inputted items are discount triggering items comprises comparing each of the inputted unique codes of the inputted items with information in the database (see Col. 7, lines 10-15).

With regard to Claims 16, 17, 38 and 39, Greer et al. discloses the unique codes are all scanable by a scanning device and the unique codes may be input manually (see Col. 6, lines 15-17).

With regard to Claims 18 and 40, Greer et al. discloses issuing a description associated with each of the bundles, which description is associated with the unique code for that bundle (see Col. 9, lines 36-45).

With regard to Claims 19, 20, 41 and 42, Greer et al. discloses printing the redemption information on a paper slip with a digitally encoded region disposed thereon which contains information regarding the information contained within the paper slip, which digitally encoded

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information can be optically retrieved at a later time and wherein the digitally encoded region comprises a bar code (see Col. 7, lines 4-7).

With regard to Claims 21 and 43, Greer et al. discloses each transaction has associated therewith a unique identification number (UID) and further comprising the step of printing the UID for the transaction on a paper containing the redemption information (see Col. 8, lines 25-32, describing that each certificate has a UID in the form of a bar code printed thereon).

With regard to Claims 23 and 45, Greer et al. discloses purchasing the redemptionable item by presenting a paper comprising the redemption (see Col. 5, lines 45-49).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 22 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al.

Greer et al. discloses a product information table is provided for all items having a unique code (see Col. 5, lines 30-33, describing the item record file) and further comprising the step of creating a redemption table providing additional parameters associated with discount triggering items defining the ones of the items in the product information table as discount triggering items (see Col. 5, lines 35-40, describing the cumulative discount database) and wherein the step of discriminating comprises comparing each of the multiple items and the associated unique code with information in the modified product information table, and when the unique code in the modified product information table has information associated therewith, defining it as a discount triggering item, and declaring that item a discount triggering item (see Col. 7, lines 10-22, describing the checking of the trigger flag in the item record file to determine if the item generates a discount).

Greer et al. does not specifically disclose creating a modified product information table by merging the redemption table with the product information table such that each unique code has associated therewith information regarding the identification of a product having that unique code, and that constitutes a discount triggering item. However, it is very well known in the art to

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merge databases to form new databases. Therefore, it would have been obvious to one skilled in the art at the time of the invention to merge the item record file and the cumulative discount database of Greer et al. into a new database in order to be able to have faster access to the discount information for a product triggering a discount due to the fact that the information would be located in a single database.

13. Claims 4, 5, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. as applied to Claims 3 and 27, respectively, above, and further in view of Off et al., U.S. Patent No. 5,612,868.

Greer et al. does not specifically disclose filtering the discount triggering items such that if the quantity of discount triggering items purchased is less than a predetermined minimum quantity for each of the unique codes, a bundle is not created and limiting the number of discount triggering items that can be contained in any one of the bundles to a maximum number.

Off et al. discloses that a discount is not generated unless a minimum quantity is purchased and limiting the number of discount triggering items that can be contained in any one of the bundles to a maximum number (see Col. 10, lines 42-57, describing that a predetermined number is used to determine if a trade deal is available, such that the predetermined number could be used to set a minimum or a maximum value). Therefore, it would have been obvious to one skilled in the art at the time of the invention to use the filtering techniques of Off et al. in the filtering steps of Greer et al. in order to be able to more precisely control the conditions under which a discount

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certificate will be generated and thereby more accurately target the discounts to a specific customer group.

14. Claims 6 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. as applied to Claims 1 and 25, respectively, above, and further in view of Mindrum et al., U.S. Patent No. 4,723,212.

Greer et al. does not specifically disclose summing one or more bundles, the total sum of which is limited to a maximum value. Mindrum et al. discloses the limiting of the number of coupons printed for a session to a maximum number (see Col. 11, lines 37-40), which would equate to giving a the customer a maximum total value of discounts for a session. Therefore, it would have been obvious to one skilled in the art at the time of the invention to limit the value of the discount certificate of Greer et al. to a maximum value as taught or suggested by Mindrum et al. in order for a manufacturer to be able to efficiently account for the total amount of discounts that will be generated and thereby more effectively control the amount of discounts distributed.

15. Claims 8, 9, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. as applied to Claims 7 and 31, respectively, above, and further in view of Suda, U.S. Patent No. 5,481,094.

Greer et al. does not specifically disclose that step of issuing cash register receipt information and the step of issuing the redemption information comprise the step of printing a

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paper receipt comprising both the cash register receipt information and the redemption information and the step of printing the paper receipt comprises the step of providing a cut between a paper portion of the paper receipt comprising the cash register receipt information paper and a paper portion of the paper receipt comprising the redemption information, that is not complete, such that the paper portion with the redemption information is easily detachable from the paper portion with the cash register information.

Suda discloses printing a paper receipt comprising both the cash register receipt information and the redemption information (see Figure 4A and Col. 5, lines 45-52) and providing a cut between the cash register receipt information paper the redemption information, such that the redemption information is easily detachable from the cash register information (see Figure 4A and Col. 5, lines 45-52, describing the perforation between the two parts which includes a cut). Therefore, it would have been obvious to one skilled in the art at the time of the invention to issue the receipt and certificate of Greer et al. in the manner taught by Suda in order to have fast and efficient way for giving the customer his receipt and associated discount certificate with just one printer.

16. Claims 10-13, 24, 34, 35 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. as applied to Claim 1, 7, 25 and 31, respectively, above, and further in view of Valencia et al., U.S. Patent No. 5,380,991.

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Greer et al. does not specifically disclose providing a purchaser with electronic code comprising the cash register receipt information and providing the consumer with an electronic code comprising the redemption information, wherein the electronic code is recordable on a card having magnetic media. Greer et al. also does not specifically disclose that the redemptionable item is obtained by presenting electronic code having the redemption information.

Valencia et al. discloses providing a purchaser with electronic code comprising the cash register receipt information (see Col. 6, lines 6-21, describing the storing of information regarding purchased items, i.e. receipt information, on the smart card), providing the consumer with an electronic code comprising the redemption information (see Col. 7, lines 7-12, describing the adding of additional discounts to the smart card) and that the redemptionable item is obtained by presenting electronic code having the redemption information (see Col. 3, lines 20-30, describing the presenting of the smart card to obtain discounts). Therefore, it would have been obvious to one skilled in the art at the time of the invention to issue the receipt and certificate of Greer et al. in the manner taught by Valencia et al. in order to have fast and efficient way for giving the customer his receipt and associated discount certificate for later use by the customer in obtaining the discount.

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Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sakai et al. discloses a POS system. Pruchnicki, Lotvin et al., McCarthy and Robinson et al. disclose coupon or award systems.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-1396, (for informal or draft communications, please label
"PROPOSED" OR "DRAFT")

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Sattizahn whose telephone number is (703) 305-3891. The examiner can normally be reached on Monday-Thursday from 7:15am to 4:45pm. The examiner can also be reached on alternate Fridays.

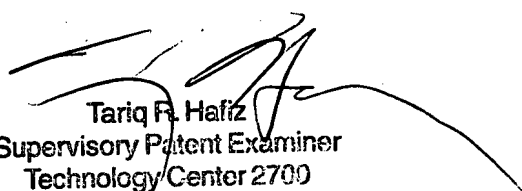
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz, can be reached on (703) 305-9643. The fax phone number for this Group is (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

BTS

bts

July 1, 1999


Tariq R. Hafiz
Supervisory Patent Examiner
Technology Center 2700